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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,982	07/31/2003	James Dunman	29953.184828	1857
26694	7590	07/06/2005	EXAMINER	
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20045-9998			PARKER, FREDERICK JOHN	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,982

Applicant(s)

DUNMAN, JAMES

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Specification

The amendments in response to the Objections to the specification of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

Claim Rejections - 35 USC § 112

The amendments in response to the 35 USC 112 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections of the previous Office action.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 17-20 now include limitations that shields do not hold a threaded engagement portion of a finish of the containers for which Applicants failed to cite support in the original filing, nor was support found by the Examiner.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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1. Claims 1-4,6,8-12,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carl et al US 3740259 in view of White US 4667620.

Carl teaches a method of coating threaded glass containers, in which the threaded closure portion of the container 12 is snugly fit into a threaded masking chuck 18 of body member 10 on support means 21, which in turn is part of a conveyor means 25. The threaded masking means is a "shield" to prevent coating of threaded portions of the container. The conveyor moves the containers to a coating area where they are coated by spray gun 22(without further limitation) or other coating means. See col. 3, 50 to col. 4, 26. Body member 10 may be fabricated from plastic materials such as HD PE, "Bakelite", etc without limitation as to forming method. Hence it is the Examiner's position that it would have been obvious to form such articles by known and conventional forming means, such as injection molding, because the process is conventionally used to form complex plastic polymer parts. The reference also teaches on col. 1, 47-51 that containers of plastic, ceramic, etc in addition to glass are conventionally coated by spraying or other means. However, the reference does not explicitly state the material making up the masking/ shielding means is the same as, and made from scrap of, the containers even though it is apparent from the reference that both containers and masking/ shielding means can be made of a polymeric plastic.

White also teaches the concept of coating certain portions of a container while shielding other portions from the coating material. Shielding means 114 are taught, without limitation of the material from which it is made. In col. 1, 13-22, it is specifically taught that the beverage industry is substituting polymeric plastics, and particularly the polyester polyethylene terephthalate (PET), for containers in place of glass or metal. It further teaches that containers

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must be recyclable due to state and federal mandates, and that PET material is recyclable (col. 1, 63-68; etc). The recycling of scrap material from a PET container-making operation would therefore have been an obvious variation given the teachings of White because there is simply no reason to expect that formed containers and scrap from making the same formed containers would have any difference in their ability to be recycled and reformed, absent a clear and convincing showing to the contrary. Hence it would have been obvious to substitute the glass container of Carl with an equivalent polymer plastic container to follow industry trends and comply with recycling regulations as taught by White. Carl is not limited to specific engineering polymer materials from which the masking body members are formed, and White teaches that formable/ recyclable engineering polymeric plastics such as PET are used to make threaded containers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the process of Carl et al on plastic instead of glass container to follow the industry trends disclosed by White, and further using a polymeric masking body member of recycled scrap PET from the plastic container making process because White also discloses that PET can be recycled to be re-formed into articles. Further, the use of production scrap to make the polymeric masking body would have provided an opportunity to re-form container scrap into a useful product used in container production, resulting in apparent economic benefits.

As to claims 11-12, it would have been obvious to the skilled artisan to perform maintenance on the conveyor/ production line at an interval commensurate with the use of the production line to remove and dispose of broken or mal-functioning parts, including the masking/ shielding means.

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2. Claims 5,7,13,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carl et al US 3740259 in view of White US 4667620 and further in view of the Admitted Prior Art (APA).

Carl et al and White are cited for the same reasons previously discussed, which are incorporated herein. Oxygen barrier coatings are not disclosed. However the APA discloses it is known to electrostatically apply oxygen barrier coats to plastic polymer/ PET containers, except at threaded portions, to prevent the adverse effects of oxygen migration through the walls of the containers. Since electrostatic coating encompasses electrostatic spraying, and Carl et al teaches to apply coatings to containers by “spraying”, the use of electrostatic spraying would have been an obvious variation of the teachings of Carl et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Carl et al in view of White by electrostatically spraying oxygen barrier coatings to container surfaces to prevent the adverse effects of oxygen migration through the walls of the containers.

Response to Arguments

Applicants amendments and remarks have been considered.

Applicants argue “there is no suggestion or motivation to modify or combine the references”, and even if motivation was proper, neither reference teaches the shields to be made of scraps of the first material (from which the containers are made). It is not necessary that prior art expressly suggest or in so many words make the changes or improvements the inventor made but that the knowledge may be clearly present, In re Sernaker 217 USPQ 1. In the instant case, far beyond the level of ordinary skill, it is well-known that recycling of plastic goods to reduce landfill

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waste and production costs is a conventional and integral part of our society. Nevertheless, White explicitly teaches on col. 1 54 to col. 2, 2 the “trend toward compulsive container return laws” and plastic recycling, as well as col. 4, 13-24 supports the obviousness of recycling plastic container materials. It is well-established that the artisan is presumed to know something about the art apart from what the references disclose, *In re Jacoby* 135 USPQ 317; The conclusion of obviousness maybe made from “common sense” and “common knowledge” of the person of ordinary skill, *In re Bozek* 163 USPQ 545. Thus, if the materials of the containers themselves are recyclable, simple logic dictates that material scraps from producing said containers are equally recyclable. Clear and irrefutable motivation would therefore have been suggested, if not outright taught, from the references themselves, thereby providing motivation for the combination of references. Further the Examiner gave Applicants the opportunity to show a clear and convincing showing of unexpected results, but Applicants chose to argue the issue of burden instead. The USPTO has no laboratories or test facilities to compare results, and the Examiner gave Applicants the opportunity to do so to persuade the Examiner that the process patentably distinguishes over the prior art. Their refusal to do so is duly noted, and the Examiner maintains “there is simply no reason to expect that formed containers and scrap from making the same formed containers would have any difference in their ability to be recycled and reformed”. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to carry out the process of Carl et al on plastic instead of glass container to follow the industry trends disclosed by White, and further using a polymeric masking body member of recycled scrap PET from the plastic container making process because White also discloses that PET can be recycled to be re-formed into articles. It remains the Examiner’s position that the invention is

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merely an obvious variation of the prior art, and does not patentably distinguish over the prior art.

New claims 17-20 include the limitation that the shields do not hold a threaded portion of a finish of the containers. The Examiner deems this limitation New Matter as discussed above. It is further the Examiner's position that whether or not the containers being supported were threaded, bare, notched, or whatever, these are merely functionally equivalent variations of known closing means which do not otherwise effect the container coating process, and therefore are obvious variations within the purview of one of ordinary skill, absent a clear and convincing showing to the contrary.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp